

REMARKS

This response is to the action mailed in the above-referenced case on February 8, 2008. In the action claims 17-24 stand rejected under the judicially-created doctrine of obviousness-type double patenting over Patent US 6483905, and claims 17-29 stand rejected under the judicially-created doctrine of obviousness-type double patenting over Patent US 6973167. Further, evidently claim 29 was meant to have been rejected under Title 37 USC § 112, for use of a slash symbol to represent “and” or “or”, although the examiner did not state the rejection, but only reasons for the rejection. Still further, claims 17-24 stand rejected under Title 35 USC § 102(e) over Lemaire et al., US 5444768, hereinafter Lemaire. In addition, claim 29 is rejected under Title 35 USC § 102(e) over Perlman et al., US 5896444. Also in addition, claims 25-28 stand rejected under 35 USC 103(a) as unpatentable over Lemaire in view of Clark, US 5666530, hereinafter Clark. Finally claims 25 and 26 stand rejected under Title 35 USC 103(a) over Cooper, US 6,052,442, hereinafter Cooper, in view of Perlman, in view of Clark.

Judicially-created double-patenting rejections

In regard to the rejections for double patenting the applicant has caused to be filed with this response appropriate terminal disclaimers to obviate the rejections, and requests that the rejections be withdrawn.

Rejection of claim 29 under 35 U.S.C. 112

The examiner in his rejection makes reference to applicant's use of a slash mark in the claim, and applicant has amended claim 29 to delete the use of the slash mark, referring now to the at least one audio or video output port. Applicant urges the examiner to withdraw the rejection.

Rejection of claims 17-24 under 35 U.S.C. 102(e)

The examiner states:

Regarding claim 17, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine comprising:

an interconnected CPU 40, memory 15,54-58, and modem 42 with a telephone connection (col.8, lines 18-22);

Lemaire further teaches a system for communicating stored documents to a user (fig.2; labels 13 and 20; col.7, lines 6-21, col.9, lines 18-31),

Lemaire further teaches an alert for signaling a user that new documents are waiting to be reviewed (col. 7, lines 6-21);

Lemaire further teaches an input for a user to signal the system to communicate the new documents to the user (col.5, lines 36-66), and

Lemaire further teaches a digital communication link for connecting to a host personal computer (PC), wherein the electronic document answering machine periodically connects to remote sources, receives and stores digital documents, and activates the alert apparatus as new documents are stored, and wherein, in response to the input, the electronic document answering machine communicates stored documents one-at-a-time to the user, and whereto the electronic document answering machine is adapted to communicate stored documents to the PC for processing (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24).

Applicant's response:

The examiner provides a detailed list of relied-upon portions of Lemaire above, ostensibly to read upon the limitations of applicant's claim 17. Some do so, and some do not.

Applicant's claim 17 recites "an alert for signaling a user that new documents are waiting to be reviewed." The examiner relies on Lemaire (col.5, lines 36-66), which states "Additionally, portable computer device 10 preferably includes a "busy" lamp 33 which is utilized to provide an indication of whether or not communication between

portable computer device 10 and a remote central message facility is occurring, without the need for a more complex display. "Busy" lamp 33 may preferably be implemented utilizing a low voltage light emitting diode (LED) or any other suitable means which does not require substantial power. In the depicted embodiment of the present invention, "busy" lamp 33 will be illuminated during communication between portable computer device 10 and a remote central message facility and will flash or "blink" upon completion of that communication, indicating to the-user that communication has been terminated."

Busy lamp 33 of Lemaire quite clearly is a lamp that lights when Lemaire's machine is busy downloading documents. If there are no documents waiting to be accessed in Lemaire, but the machine begins downloading a document (gets busy), the busy lamp 33 will be lit; but there will be no documents ready to be downloaded until the machine quits downloading, at which time the busy light goes off. At that point there are documents waiting but Lemaire's busy light is off. This cannot read on applicant's claimed alert.

In addition to the lack of an alert for waiting documents, Lemaire has no digital communication link for connecting to a host PC. The examiner cites teaching in Lemaire that indicate Lemaire can connect to more than one remote device for downloading messages, but there is NO teaching of a local host PC, or any connection or interaction with a local host PC. It simply isn't there.

The rejection of claim 17 over Lemaire is therefore faulty, because the teachings of Lemaire do not anticipate all of the limitations of claim 17; at least two of the limitations are not met. The applicant therefore respectfully requests that the rejection be withdrawn.

As claim 17 is patentable, claims 18-24 are patentable at least as depended from a patentable claim.

Rejection of claim 29 under 35 U.S.C. 102(e)

The examiner states:

8. Claim 29 is rejected under 35 U.S.C. 102(c) as being anticipated by **Perlman et al.** (US. 5,896,444).

Regarding claim 29, with respect to Figures 1-3, **Perlman** teaches an electronic document answering machine for use with a TV set, comprising:

an interconnected CPU 21, memory 22,23, and modem 27,30 (fig. 2B);

Perlman further teaches led [i.e., an alert] for signaling a user that new documents are waiting to be reviewed (col.7, line 63-col.8, line 11);

Perlman further teaches at least one of an audio and a video output port (fig. 2B, labels 25,26); and

Perlman further teaches an infra-red port for receiving infra-red signals from a remote controller (fig.2A, label 24);

Perlman further teaches wherein the CPU, executing stored control code, periodically connects to remote sources, and downloads and stores digital documents, and activates the alert apparatus as new documents are stored, and wherein the CPU in response to input from a user via the infra-red port, communicates stored documents one-at-a-time to a TV set via the audio/video output port (col.4, lines 16-20, col.7, line 63-col.8, line 11).

Applicant's response:

The applicant has herein cancelled claim 29, so the rejection is now moot; but the applicant reserves the right to enter and prosecute the same or similar claims in future continuing applications.

103 rejection of claims 25-28 over Lemaire in view of Clark

The examiner states:

11. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lemaire et al.** (US. 5,444,768) in view of **Clark et al.** (US. 5,666,530).

Regarding claim 25, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24);

Lemaire further teaches an LED alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (fig.1A, labels 38,33; col.7, lines 6-21); and

Lemaire further teaches an initializing input pushbutton having the LED integrated in the pushbutton, for a user to signal the system to communicate the stored documents one-at-a-time for review by the user (fig.1A, labels 38,33; col.5, lines 36-66),

However, **Lemaire** does not teach the following limitations:

"wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in full operating mode"

Clark teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Lemaire's** invention for providing reduced power consumption as taught by **Clark's** invention in order to provide flexible operation capabilities.

Regarding claim 26, **Lemaire** teaches the system of claim 25 wherein the digital documents include e-mail addressed to the PC user (col.2, lines 40-45, col.3, lines 42-46, 60-63).

Regarding claim 27, **Lemaire** teaches the system of claim 25 where the alert apparatus and the pushbutton are in a keyboard in communication with the PC.

Regarding claim 28, **Lemaire** teaches the system of claim 27 wherein the alert apparatus is an LED in a standard keyboard adapted to serve as the alert apparatus, and the input apparatus is a standard key on the keyboard adapted to serve as the pushbutton (fig.1A, labels 38, 33).

Applicant's response:

Lemaire is NOT a retrieval device in a personal computer. Clearly Lemaire is neither in nor is itself a PC. The Abstract makes it quite clear that the Lemaire machine is a specialized hand-held portable computer device.

Lemaire does not teach "an LED alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review;". As pointed out above, Lemaire has a busy lamp for indicating to a user that the machine is busy downloading. That does NOT indicate that documents are waiting for review.

Further Lemaire does NOT anticipate a lighted pushbutton that both signals that there are documents waiting for review, and to signal the machine to communicate the documents one-at-a-time. There may be an initializing button, but it doesn't light, and there is no disclosure in Lemaire of a "documents ready" light, much less integrated with the "Start" button.

Further still, Clark teaches a power-down mode, but the mere existence of a power-down mode cannot suffice to anticipate operating the functions claimed during a power-down period.

So the 103(a) rejection of claim 25 fails on several points, and the applicant respectfully requests that it be withdrawn.

As claim 25 is patentable, claims 26-28 are patentable at least as depended from a patentable claim.

103 rejection of claims 25-26 over Cooper in View of Perlman in view of Clark

The examiner states:

12. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cooper et al.** (U.S. 6,052,442) in view of **Perlman et al.** (US. 5,896,444) further in view of **Clark et al.** (U.S. 5,666,530).

Regarding claim 25, with respect to Figures 1 and 2, **Cooper** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (col.1, lines 20-29, col.4, lines 37-43);

Cooper further teaches an alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (col.4, lines 41-43, col.4, lines 59-67); and

Cooper further teaches an initializing input for a user to signal the system to communicate the stored documents one-at-a-time for review by the user (col.4, lines 43-47, col.7, lines 15-20),

However, **Cooper** does not teach the following limitations:

"an LED alert apparatus" and "input pushbutton having the LED integrated in the pushbutton"

Perlman teaches an LED alert apparatus and input pushbutton having the LED integrated in the pushbutton (fig.1A, labels 38,33; col.5, lines 36-66). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add LED indicator to **Cooper's** invention for providing alerting as taught by **Perlman's** invention in order to provide visual notification.

Cooper in view of **Perlman** further does not teach the following limitations:

"wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in full operating mode"

Clark teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Cooper's** invention in view of **Perlman's** invention for providing reduced power consumption as taught by **Clark's** invention in order to provide flexible operation capabilities.

Regarding claim 26, **Cooper** teaches the system of claim 25 wherein the digital documents include e-mail addressed to the PC user (col.8, lines 6-12).

Applicant's response:

Again, the examiner is reaching a bit in these rejections. The applicant claims a retriever for periodically accessing remote sources; the examiner relies on Cooper (col.1, lines 20-29, col.4, lines 37-43); Col 1, lines 20-29 indicate an answering machine might be integrated with a computer; col. 4 lines 37-43 indicates both email and voice messages may be accessed, but is silent on the limitation of periodically accessing a remote source.

Further, the examiner provides Cooper (col.4, lines 41-43, col.4, lines 59-67) to anticipate applicant's LED alert apparatus. The examiner drops the LED part of the recited claim to help the reference; but the relied-upon portion of the reference does not teach an LED apparatus, it teaches a display on the computer screen.

For the initializing input having an integrated LED the examiner relies on Cooper (col.4, lines 43-47, col.7, lines 15-20) for the initializing input, and Perlman (fig.1A, labels 38, 33; col.5, lines 36-66) for the integration of LED with a pushbutton for input. After some confusion the applicant discovered that the reliance is actually on Lemaire, not Perlman. Perlman does not have a Fig. 1A, but Lemaire does, with element number 33 and 38 as well. However, 38 and 33 are not the same button, and cannot read on the claimed limitation of an LED integrated in the pushbutton. Further, the text reference col. 5, lines 36-66, describes generally a control interface for Lemaire's machine, but is completely silent on a start pushbutton with a built-in LED that signals a user that there are documents ready to review.

So the rejection clearly fails before we ever get to Clark. Cooper and Lemaire do not teach what the examiner alleges they do teach. The rejection should be withdrawn.

So claims 25 -28 are clearly patentable over the art cited and applied, taken either singly or in combination.

Summary

Applicant believes all of the claims standing for examination are patentable over the art cited and applied, either singly or in combination, and therefore applicant respectfully requests reconsideration and that the present case be passed quickly to issue.

If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
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